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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 09/621,788 | 07/21/2000 | Daniel Casalini | 12707 P03 | 4984 |
| 7590 | 11/28/2003 | | EXAMINER | |
| Jerry Cohen Perkins, Smith & Cohen One Beacon Street Boston, MA 02108 | | | KEEHAN, CHRISTOPHER M | |
| | | ART UNIT | PAPER NUMBER | |
| | | 1712 | | |

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/621,788 | CASALINI, DANIELE |
| | Examiner | Art Unit |
| | Christopher M. Keehan | 1712 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5,8-12 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5,8-12 and 15-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) Interview Summary (PTO-413) Paper No(s) _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

The rejection of claims 1-8, 12, and 16-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Saam (4,244,849) has been maintained and is as set forth in the previous office action.

The rejection of claims 1-3, 5-12, and 14, 15, 17, and 18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Swei (5,182,173) has been maintained and is as set forth in the previous office action.

The rejection of claim 1 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al. (5,991,591) has been maintained and is as set forth in the previous office action.

The rejection of claims 1-3 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Neal (6,510,777 B2) has been withdrawn due to applicant's arguments.

New Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 8-12, and 15-18 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Single hard grids are critical or essential to the practice of the invention, but are not included in the claim(s) and are not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In claim 1, applicant has amended the claim to include "single hard grids," and there appears to be no support in the specification or the original claims for this subject matter.

Response to Arguments

Applicant's arguments filed 9/25/03 have been fully considered but they are not persuasive. Regarding applicant's arguments concerning the 102/103 rejection of claims 1-8, 12, and 16-18 over Saam (4,244,849), on page 8 of applicant's response, that Saam is directed toward elastomeric layers and that the instant claim 1 is drawn to a surface coated hard material comprising single hard grids which are coated by a polysiloxane layer, it should be noted that applicant has not claimed a polysiloxane layer that is non-elastomeric, and therefore Saam still reads on the claims. Regarding the added limitation of single hard grids, as the hard material of Saam is the same as used by applicant, and applicant has not disclosed how the single hard grids are created, it appears that the hard material of Saam also would possess these single hard grids.

Regarding applicant's arguments concerning the 102/103 rejections of claims 1-3, 5-12, and 14, 15, 17, and 18 over Swei (5,182,173), applicant has stated that Swei teaches an inorganic core and a layer of a silicone that covers the inorganic core and is

chemically bound thereto (page 9, first paragraph of applicant's response). This teaching directly reads on the instant claim 1. Applicant has claimed a surface coated hard material, the surface of which has a polysiloxane coating. This appears to be within the teachings of Swei. Regarding the added limitation of single hard grids, as the hard material of Swei is the same as used by applicant, and applicant has not disclosed how the single hard grids are created, it appears that the hard material of Swei also would possess these single hard grids.

Applicant has not argued the merits of the 103(a) rejection of claim 13 over Swei (5,182,173) in view of Erickson et al. (5,645,619) in this response.

Regarding applicant's arguments concerning the rejection of claim 1 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al. (5,991,591), applicant has argued that the presently claimed invention differs in that it requires hard material grids, the hard material of Chen et al. is the same as used by applicant, and applicant has not disclosed how the single hard grids are created, it appears that the hard material of Chen et al. also would possess these single hard grids.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Keehan whose telephone number is (703) 305-2778. The examiner can normally be reached on Monday-Friday, from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ~~Robert A. Dawson~~ can be reached on ~~305-2778~~. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Christopher Keehan *CK*
November 13, 2003



Robert Dawson
Supervisory Patent Examiner
Technology Center 1700